

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

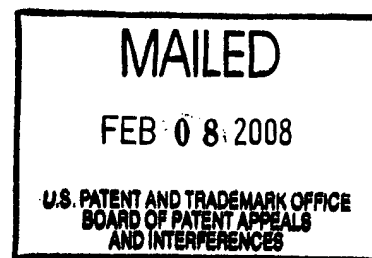
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Ex parte EMMA A. DURAND and MICHAEL J. PALOMBO

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Application 10/686,815

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on January 28, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

**EXAMINER ANSWER**

The Examiner's Answer mailed November 3, 2006, does not fully comply with the requirements of 37 C.F.R. § 41.37. The following headings do not include all the requirements under these headings in accordance with MPEP § 1207.02:

**“Grounds of Rejection.”** For each ground of rejection maintained by the examiner and each new ground of rejection (if any), an explanation of the ground of rejection.

. . . . (d) For each rejection under 35 U.S.C. 103, the examiner's answer must:

(i) state the ground of rejection and *point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on* in the rejection,

(ii) *identify the differences between the rejected claims and the prior art relied on (i.e., the primary reference)*, and

(iii) explain why it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified the primary reference to arrive at the claimed subject matter. . . .

(e) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. . . .

**“Response to Argument.”** A statement of whether the examiner disagrees with each of the contentions of appellant in the brief with respect to the issues presented and an explanation of the reasons for disagreement with any such contention. *The examiner must use headings and subheadings paralleling the headings and subheadings utilized in the appellant's brief.*

A revised Examiner's Answer that is in full compliance with 37 C.F.R. § 41.37 is required.

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**INFORMATION DISCLOSURE STATEMENT**

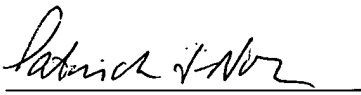
In addition, an Information Disclosure Statement (IDS) was filed on August 3, 2006. It is not apparent from the record whether the Examiner considered the statement submitted or notified Appellants regarding why their submission did not meet the criteria set forth in 37 C.F.R. §§ 1.97 and 1.98. A communication notifying Appellants of the Primary Examiner's decision is required.

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Accordingly, it is **ORDERED** that the application is return to the Examiner to:

- 1) submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and
- 2) consider the IDS filed August 3, 2006, with appropriate notification to Appellants regarding the Primary Examiner's decision;
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

  
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